

THIS DISPOSITION IS  
NOT CITABLE AS PRECEDENT  
OF THE TTAB

Mailed: March 28, 2005

**UNITED STATES PATENT AND TRADEMARK OFFICE**

---

**Trademark Trial and Appeal Board**

---

In re Novak Jody Limited Liability Company

---

Serial No. 78277280

---

David Leit of Lowenstein Sandler PC for Novak Jody Limited Liability Company.<sup>1</sup>

Brian J. Pino, Trademark Examining Attorney, Law Office 114 (Margaret Le, Managing Attorney).

---

Before Hohein, Chapman, and Holtzman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Novak Jody Limited Liability Company filed on July 22, 2003, an application to register on the Principal Register the mark POD for "advertising services, namely, dissemination of advertising for others via an electronic communication network" in International Class 35. The

---

<sup>1</sup> From the filing of the application through briefing, applicant was represented by J. Mark Pohl, Esq. Of Pharmaceutical Patent Attorneys, LLC. In November 2004, applicant filed a revocation of all previous powers of attorney and appointed the attorney listed above.

application is based on applicant's assertion of a bona fide intention to use the mark in commerce.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of the previously registered mark THE POD for "online shopping services, featuring a wide variety of consumer goods; advertising and promotional services for others in the nature of dissemination of advertisements and promotions via online electronic communications and multi-user global communications networks; providing comparative shopping information via online electronic communications and multi-user global computer networks; market research and analysis services for others" in International Class 35.<sup>2</sup>

The Examining Attorney also made final his requirement for full compliance with his request for information under Trademark Rule 2.61(b), by which he specifically asked the following three questions of applicant: (1) "Does POD have any significance as applied to the goods or services other than trademark significance?"; (2) "Does POD have any significance in the relevant trade or industry other than trademark significance?"; and (3) "Does the applicant

---

<sup>2</sup> Registration No. 2359019, issued June 20, 2000. The registration also includes services in International Class 42, but those services were not referenced by the Examining Attorney as a basis for the refusal to register applicant's mark.

manufacture or offer any of the goods and/or services that appear in the registrant's identification of goods and/or services?"

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

Turning first to the Examining Attorney's requirement for information under Trademark Rule 2.61(b), applicant in response thereto provided a declaration from Jody L. Novak-Torre, the managing member of applicant company, specifically responding to the three questions posed by the Examining Attorney. In the Final Office action dated May 3, 2004 (p. 3), the Examining Attorney, without explanation or any reference to the statements made in applicant's declaration addressing the questions, simply stated that "the applicant failed to provide the information requested...."

Applicant argues that the Examining Attorney's refusal to consider the declaration is impermissible and the requirement for further information must fail.

In his brief on the case, the Examining Attorney argues that applicant failed to "fully comply" with the requirement for information. He explains that in answering the first question, applicant referred to the services in

the "registration application" rather than clearly referring to applicant's services as the question requested; and asserts that as to the third question, when asked if applicant offered any of the registrant's services, applicant answered only that it is offering those identified in its application.

It is unclear why the Examining Attorney made no explanation of the asserted deficiency of applicant's response to the Trademark Rule 2.61(b) requests in the Final Office action. Certainly, the better practice is for the Examining Attorney to be clear as to why the response is insufficient. In any event, his assertion that the information in response to question one did not clearly refer to applicant's services is not well taken.

Immediately after the words "registration application" in applicant's declaration, applicant recites the exact identification of services in this pending application for registration of its mark. With regard to the third question, the Examining Attorney argues that this question was "to allow the examining attorney to have a better understanding of whether the respective goods and/or services commonly emanate from the same source." (Brief, p. 4.) While applicant responded that it was using the mark for its own services, it is reasonable to interpret

that, by negative implication, applicant answered the question.

We find that the Examining Attorney's requirement under Trademark Rule 2.61(b) for additional information about the goods was appropriate, but that applicant made a reasonable attempt to respond to the Examining Attorney's requirement for further information, and that there is sufficient compliance with the Examining Attorney's request for information under Trademark Rule 2.61(b).

The cases cited by the Examining Attorney -- *In re DTI Partnership LLP*, 67 USPQ2d 1699 (TTAB 2003); *In re SPX Corporation*, 63 USPQ2d 1592 (TTAB 2002); and *In re Babies Beat Inc.*, 13 USPQ2d 1729 (TTAB 1990) -- are readily distinguishable from the facts regarding the Trademark Rule 2.61(b) requirement in this case. Here, applicant adequately responded to the requests for information, rather than ignoring such or being evasive.

We turn next to the Examining Attorney's refusal to register the mark on the Principal Register under Section 2(d) of the Trademark Act. Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We consider first the marks. Applicant's mark POD is highly similar to the cited mark, THE POD. The only difference is that applicant did not include in its mark the word "THE." The word "the" is generally devoid of trademark or source indicating significance. See e.g., *In re Dixie Restaurants*, supra (the Court affirmed the Board's finding of likelihood of confusion between THE DELTA CAFE and design for restaurant services and DELTA for, inter alia, restaurant services). See also, *In re Armour and Company*, 220 USPQ 76 (TTAB 1983); and *The Conde Nast Publications Inc. v. The Redbook Publishing Company*, 217 USPQ 356 (TTAB 1983). (Both of these cases involved a finding that the involved mark was generic.) This minor difference (absence of the word "the") would not obviate any likelihood of confusion. See *Spoons Restaurants Inc. v. Morrison, Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd*

unpub'd (Fed. Cir., June 5, 1992). Instead, we find that the marks POD and THE POD are virtually identical in sound, appearance, connotation and commercial impression. See *In re Dixie Restaurants*, supra; and *Weiss Associates Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990).

Turning to the similarities/dissimilarities in and the nature of the involved services, we must determine the issue of likelihood of confusion on the basis of the goods and/or services as identified in the application and the registration, and in the absence of any specific limitations therein, on the basis of all normal and usual channels of trade and methods of distribution for such goods. See *Octocom Systems Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983); *Squirtco v. Tomy Corp.*, 697 F.2d 1034, 216 USPQ 937 (Fed. Cir. 1983); and *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973).

It is well settled that goods or services need not be identical or even competitive to support a finding of

likelihood of confusion, it being sufficient instead that the goods or services are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); and *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001).

It is not necessary that a likelihood of confusion be found as to each item included within one class in the cited registrant's registration vis-a-vis an applicant's identification of goods or services. See *Squirtco v. Tomy Corporation*, supra; *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981); and *Alabama Board of Trustees v. BAMA-Werke Curt Baumann*, 231 USPQ 408, n. 7 (TTAB 1986).

We thus focus on the most relevant identified services in the cited registration, specifically, "advertising and promotional services for others in the nature of dissemination of advertisements and promotions via online electronic communications and multi-user global communications networks" vis-a-vis applicant's identified services of "advertising services, namely, dissemination of



advertising for others via an electronic communication network."

The portion of the cited registrant's services relating to advertising services for others in the nature of disseminating advertisements and promotions via online electronic communications and applicant's advertising services, namely, disseminating advertising for others via an electronic communication network, are highly similar as identified. In fact, we find that these are legally identical services, as identified. Applicant has not argued that the services are unrelated.<sup>3</sup>

Likewise, we do not find any differences in the channels of trade or purchasers for such services. We must presume, given the identifications (neither of which is limited), that the services are offered through the same channels of trade, and are purchased by the same classes of purchasers. See *Canadian Imperial Bank v. Wells Fargo Bank*, supra.

Applicant strongly contends (devoting most of its brief to this position) that the refusal to register based on likelihood of confusion is "impermissible as a matter of

---

<sup>3</sup> We disagree with applicant's argument that the "likelihood of confusion rejection is premised on judicially-noticed facts [the similarities of the marks and the services are closely related]." (Brief, p. 8.)

law" (brief, p. 3) because examination by the USPTO of a third-party application for the same mark and identical services resulted in allowance of the application despite the existence of the cited registration;<sup>4</sup> and that refusing registration to applicant when the USPTO did not refuse registration to the prior third-party applicant violates "Federal law, Federal Constitutional law, and Federal common law." (Brief, p. 3.) Specifically, applicant contends that the Administrative Procedure Act requires the USPTO to treat the prior third-party applicant and the current applicant equally; that the common law of estoppel precludes the Examining Attorney from contradicting the USPTO's prior factual finding; and that when "different litigants share identical factual circumstances, inconsistent judgments may violate Seventh Amendment due process guarantees." (Brief, p. 5.)<sup>5</sup>

---

<sup>4</sup> Application Serial No. 76068421, filed June 13, 2000 by Omnipod, was published for opposition on November 13, 2001, and a notice of allowance was mailed February 2, 2002. The application was held abandoned in 2003.

<sup>5</sup> Applicant states that the "closest case addressing this point appears to be dicta in Parklane Hosiery Co., Inc. v. Shore, 439 U.S. 322 (1979)." (Brief, p. 5.) We note that the Parklane case involved, inter alia, whether the use of collateral estoppel would violate petitioners' right to a jury trial under the Seventh Amendment. It is the Fifth Amendment to the Constitution which refers to due process. (See also, the Fourteenth Amendment regarding due process.)

We do not disagree with many of applicant's general statements of law. However, in the context of the registrability of trademarks as determined at the USPTO, we disagree that the USPTO must take a similar or identical action in a current case as it did in an action from the past even if either the past action or the current action was and/or is erroneous under the law. As stated by the Commissioner in *In re Stenographic Machines, Inc.*, 199 USPQ 313, 317 (Comm. 1979): "Consistency of Office practice must be secondary to correctness of Office practice. The present case must be determined on the basis of the facts presented." While uniform treatment under the Trademark Act is highly desirable, the Board's statutory duty under Sections 17 and 20 of the Trademark Act, 15 U.S.C. §§1067 and 1070, is to determine, based upon the record before us, whether applicant's mark is registrable. The determination of registrability of that particular mark by a prior Trademark Examining Attorney cannot control the merits in the case now before us. See *McDonald's Corp. v. McClain*, 37 USPQ2d 1274 (TTAB 1995); and *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994). Neither the Board nor any court is bound by prior decisions of Trademark Examining Attorneys, and each case must be decided on its own merits, on the basis of the record therein. See *In re Nett Designs*

Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). See also, In re Kent-Gamebore Corp., 59 USPQ2d 1373 (TTAB 2001).

With specific regard to the Administrative Procedure Act and the requirement that federal agencies treat like cases alike, see the Board's thorough analysis of this argument in In re Wilson, 57 USPQ2d 1863, 1870-1871 (TTAB 2001). See also, In re International Flavors & Fragrances Inc., 181 F.3d 1361, 51 USPQ2d 1513, 1518 (Fed. Cir. 1999).

The Board, furthermore, is an administrative tribunal and accordingly has no authority to make findings regarding constitutional claims. See TBMP §102.01 (2d ed. rev. 2004), and the authorities cited therein.

Considering all of the relevant du Pont factors, we conclude that consumers familiar with registrant's advertising services for others offered under the mark THE POD would be likely to believe, upon encountering applicant's mark POD for advertising services for others, that both originate with or are somehow associated with or sponsored by the same entity.

**Decision:** The refusal to register based on the requirement for further compliance with the request for information under Trademark Rule 2.61(b) is reversed. The

**Ser. No. 78277280**

refusal to register under Section 2(d) of the Trademark Act  
is affirmed.